Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID K. TIPTON,
DARREN W. GOZY and
DAVID A. COLEMAN

Appeal No. 1998-0578
Application 08/349,633[1]

ON BRIEF

Before McKELVEY, Senior Administrative Patent Judge, and SCHAFER and LEE, Administrative Patent Judges.

LEE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's rejection of appellants' claims 21, 22 and 38.

Claims 22 and 38 each depend from independent claim 21.

Claims 1-20, 25, 28-37 and 39 have been allowed.

References relied on by the Examiner

Stanczyk et al. (Stanczyk)	Patent No. 5,532,928	July 2, 1996

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[1] Application for patent filed November 30, 1994

The Rejections on Appeal

Claims 21, 22 and 38 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Stanczyk.

The Invention

The invention is directed to a user-controlled hazardous material management system. Independent claim 1 is representative and is reproduced below:

> 21. A user-controlled hazardous material management system for relatively small, medium and a large size organizations comprising:
>
> a computer;
>
> a data storage device coupled to the computer;
>
> a display device coupled to the computer;
>
> a user input device coupled to said computer; and
>
> a hazardous material container classification system stored in said data storage device for access by said user through said input device and including:
>
> first data representing containers storing hazardous materials that are in-use;
>
> second data representing containers storing hazardous materials that are

> classified as waste hazardous materials; and
>
> said first and second data representing said containers of in-use hazardous materials and waste hazardous materials being designated as pure hazardous materials, as the trade names of the hazardous material, as a preset mixture of hazardous materials, or as a variable mix of hazardous materials so as to enable such system to track each container of hazardous material in any one of said designations from its beginning as an in-use hazardous material through its disposal as a waste hazardous material.

Opinion

The rejection of claims 21, 22 and 38 under 35 U.S.C. § 102(e) as being anticipated by Stanczyk cannot be sustained.

A reversal of the rejection on appeal should not be construed as an affirmative indication that the appellants' claims are patentable over prior art. We address only the positions and rationale as set forth by the examiner and on which the examiner's rejection of the claims on appeal is based.

Anticipation is established only when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of the claimed invention.

In re Spada, 911 F.2d 705, 707, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990); RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). See also In re King, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986); Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984). The prior art reference must either expressly or inherently describe each and every limitation in a claim. Verdegaal Bros. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987).

Claim 21 recites a data storage device having information for access by users through an input device coupled to a computer. The data storage device stores a particular "hazardous material container classification system" which includes a first type of data and a second type of data. The first data represent "containers storing hazardous materials that are in use," and the second data represent "containers storing hazardous materials that are classified as waste hazardous materials." Further according to claim 21, both the first and second data are designated as either (1) pure

hazardous materials, (2) materials identified by the trade names of the hazardous materials, (3) a preset mixture of hazardous materials, or (4) a variable mixture of hazardous materials. Claim 21 specifies that the classification enables "such system to track each container of hazardous material in any one of said designations from its beginning as an in-use hazardous material through its disposal as a waste hazardous material."

The key to this appeal centers around the claimed recitation of "first data representing containers storing hazardous materials that are **in-use** (emphasis added)." The appellant's specification in lines 21-23 on page 54 defines the term as follows: "As stated above, the term in-use is used to define a group of chemical containers that are maintained in inventory **and are presently being used**" (emphasis added). In contrast, the specification in lines 11-14 on the same page defines "waste" as "a grouping of chemical containers of chemical stock waiting to be disposed of and removed from the inventory systems." It is manifestly clear that in light of the appellants' specification, hazardous

materials which are in-use do not and cannot include hazardous materials that are regarded as waste.

The examiner erred in failing to recognize the difference between hazardous materials which are in-use and hazardous materials which are classified as waste. In the examiner's answer on page 4, the examiner discusses in-plant "raw materials" (raw materials produced by the plant) and raw materials coming into the plant. How that discussion relates to the appellants' claimed distinction between hazardous materials that are "in-use" and hazardous waste materials is not apparent. In the context of the claims on appeal, whether a material is produced within the plant or received from outside the plant does not seem relevant. What matters is that there is first data representing containers storing hazardous materials that are in-use and second data representing containers storing hazardous materials that are classified as waste.

The category of hazardous materials that are in-use is not so broad as to encompass hazardous materials which are regarded as waste. To the extent that the examiner has taken that position, the examiner erred.

The appellant acknowledges that Stanczyk discloses a system for considering treatment, storage and disposal of waste material, that Stanczyk provides “cradle-to-grave” tracking of waste from the time of generation of the waste to the time of their disposal, and that Stanczyk provides for tracking of individual containers of hazardous materials (Brief at page 12).

But that is not sufficient to support an anticipation rejection

of claims 21, 22 and 38. The examiner has not identified or discussed any disclosure in Stanczyk which teaches the storing of data representing “containers storing hazardous materials that are in-use” as opposed to containers storing hazardous materials that are classified as waste. The examiner has not shown that in Stanczyk there is first data which pertain to containers storing hazardous materials that are in-use, and separate second data which pertain to containers storing hazardous waste materials.

For the foregoing reasons, the rejection of claim 21 as being anticipated by Stanczyk cannot be sustained. Claims 22 and 38 each depend from claim 21 and thus include all features

recited in claim 21. Accordingly, the rejection of claims 22 and 38 as being anticipated by Stanczyk also cannot be sustained.

Conclusion

The rejection of claims 21, 22 and 38 under 35 U.S.C. § 102(e) as being anticipated by Stanczyk is reversed.

REVERSED

FRED E. McKELVEY, Senior Administrative Patent Judge	)
RICHARD E. SCHAFER Administrative Patent Judge	) BOARD OF PATENT APPEALS AND INTERFERENCES
JAMESON LEE Administrative Patent Judge	)

Alfred E. Hall
JONES DAY REAVIS AND POGUE
2300 Trammell Crow Center
2001 Ross Avenue
Dallas, TX 75201